

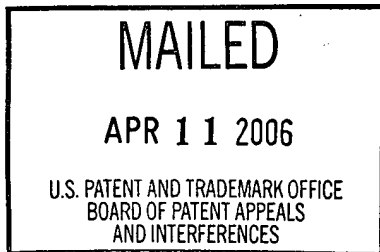
The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID A. NEWSOME

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Appeal No. 2006-0824  
Application No. 09/634,054

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ON BRIEF

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Before OWENS, GROSS and LEVY, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from a rejection of claims 27-29 and 31.  
Claims 1-26, 32 and 33 have been canceled. Claims 30 and 34-36  
have been allowed.

*THE INVENTION*

The appellant claims an apparatus for performing electrophoresis on a patient's eye, having a light-activated power source. Claim 27 is illustrative:

27. An apparatus for performing electrophoresis on a patient's eye comprising:
- a) a composite contact lens structure that comprises an outer shell having a concave surface and a convex surface;
  - b) a disposable lens member that removably fits the shell at the concavity; and
  - c) the convex portion of the shell carrying an electrode for transmitting electrical current to the shell and lens member;

a light-activated power source for providing electricity to the electrode.

*THE REFERENCE*

Beck	6,319,240	Nov. 20, 2001
		(filed May 25, 1999)

*THE REJECTION*

Claims 27-29 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Beck in view of the appellant's admitted prior art.

*OPINION*

We reverse the aforementioned rejection. We need to address only the sole independent claim, i.e., claim 27.

It is undisputed that Beck discloses each element of claim 27 except the light-activated power source. Beck discloses that "[t]he subsequent discussion contained herein will be directed to the various configurations and embodiments of iontophoretic apparatus **20** which may be used in cooperation with various power supplies and/or dose controllers" (col. 5, lines 25-29). For the light-activated power source the examiner relies (answer, page 4) upon the following disclosure in the appellant's specification: "Photovoltaic contact lens 141 includes thereon or therein a flexible light-activated iontophoretic power source 120 (dilation enhancer power supply - commercially available)" (page 7, lines 20-22).

The mere fact that light-activated power supplies were commercially available is not sufficient to establish a prima facie case of obviousness. The examiner must provide evidence which would have fairly suggested, to one of ordinary skill in the art, a light-activated power source in the context of an electrophoresis apparatus, and the examiner has not done so.

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The examiner argues that the appellant has not disclosed any criticality to using a light-activated power source (answer, page 5). It is the examiner who has the initial burden of establishing a prima facie case of obviousness, see *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976), and the examiner has not met that burden by at least providing prior art that would have fairly suggested, to one of ordinary skill in the art, a light-activated power source in the context of an electrophoresis apparatus.

We therefore reverse the examiner's rejection.

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### DECISION

The rejection of claims 27-29 and 31 under 35 U.S.C. § 103 over Beck in view of the appellant's admitted prior art is reversed.

REVERSED

Terry J. Owens  
TERRY J. OWENS  
Administrative Patent Judge

Anita Pellman Gross  
ANITA PELLMAN GROSS  
Administrative Patent Judge

Stuart S. Levy  
STUART S. LEVY  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

TJO/ki

Appeal No. 2005-2621  
Application No. 08/968,756

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